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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,463	10/15/2001	William C. Johnson JR.	GEO-55	3692

7590

03/04/2004

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EXAMINER

STASHICK, ANTHONY D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 03/04/2004

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,463

Applicant(s)

JOHNSON, WILLIAM C

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 18, 2004 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the international reference to Techboot WO 92/14372 (WO '372). WO '372 discloses all the limitations of the claim including the following: a boot (see Figure 2) having an outer layer 35 of leather (manually or mechanically) stretched over an oversized toe box 27 located beneath the outer layer; a layer of compressible cold insulating material 43 secured to the inside of the toe box in an uncompressed state; a lining 34 extending below the compressible cold insulating material so that the cold insulating material is not compressed (lining attached to sole and not compressing the insulating layer to the protector); an outsole 10.

Claim Rejections - 35 USC § 103

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/14372 in view of Official Notice. WO '372 discloses all the limitations substantially as claimed except for the thickness of the insulating material. Official Notice is taken that it would be obvious to one of ordinary skill in the art, at the time the invention was made, to make the insulating material any thickness to insulate the boot to hold the desired temperature. Therefore, it would have been obvious, to one of ordinary skill in the art, to make the insulation layer of WO '372 the desired thickness to insulate the boot to the desired temperature to keep the user's feet warm in cold temperatures.

6. Claims 1, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over White 3,805,419 or Adams 4,102,062 in view of WO 92/14372.

White '419 discloses all the limitations substantially as claimed including the following: a boot (see Figure 1) having an outer layer 8 (manually or mechanically) stretched over an oversized toe box 1 located beneath the outer layer; a layer of compressible cold insulating material 5 secured to the inside of the toe box in an uncompressed state (fastened to sole therefore not compressing uncompressed layer 5 to toe cap); a lining 6 extending below the compressible cold insulating material so that the cold insulating material is not compressed (lining attached to sole and not compressing the insulating layer to the protector); an outsole 9.

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Adams '062 discloses all the limitations substantially as claimed including the following: a boot (see Figure 1) having an outer layer 11 stretched over an oversized toe box 13 located beneath the outer layer; a layer of compressible cold insulating material 25 secured to the inside of the toe box in an uncompressed state (fastened to sole and not shown compressed between liner and toe box); a lining 24 extending below the compressible cold insulating material so that the cold insulating material is not compressed (lining attached to sole and not compressing the insulating layer to the protector); an outsole 14.

Neither White '419 nor Adams '062 discloses the outer layer being leather or the thickness of the insulating layer. WO '372 teaches that a leather exterior boot can have a toe box, insulating layer and lining located beneath the outer leather layer of a work boot to aid in insulating the user's foot from cold weather. Therefore, it would have been obvious, in view of WO '372, to make the boot used in each of White '419 or Adams '062 out of leather, as taught by WO '372, to aid in protecting the user's foot from impacts. With respect to the limitations of the thickness of the insulating layer, Official Notice is taken that it would be obvious to one of ordinary skill in the art, at the time the invention was made, to make the insulating material any thickness necessary to insulate the boot to hold the desired temperature. Therefore, it would have been obvious, to one of ordinary skill in the art, to make the insulation layer of the reference noted above the desired thickness to insulate the boot to the desired temperature to keep the user's feet warm in cold temperatures.

Response to Arguments

7. Applicant's arguments filed February 18, 2004 have been fully considered but they are not persuasive. Applicant argues that the layer of compressible cold insulating material of Techboot WO 92/14372 (WO '372) is shown in Figures 2 and 4 in an uncompressed state since "at least a section of the non-flammable ester foam lining 43 is secured inside the toe box in its compressed state and not in

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its uncompressed state as recited in claim 1", directing the examiner's attention to areas of less thickness in the figures. This argument is not clearly understood. As clearly can be seen in Figure 2, the density of the area under the toe box is no different than that shown of 43 elsewhere in the shoe. Therefore, since the other portions of the ester foam 43 are in an uncompressed state, then this area must also be in the same state. The lesser thickness of this portion does not indicate a compression of the portion but only that the portion is not as thick here as it is elsewhere. If the portion under 27 was the same thickness as that under 46, then this portion would bulge into the foot cavity as there is nothing there to hold it and prevent it from doing so. Applicant further argues that the outer layer of White is not stretched over the toe box and the toe box of White is not oversized. This, also, is not clearly understood. The toe box of White, when placed in a shoe sized for a size 12 foot would be oversized for a size 9 foot. Furthermore, since the outer layer is stretched over the toe box of White, although not tightly, as it had to be pulled over this area of the shoe, even if the toe box is placed within the shoe after manufacture. With respect to applicant's arguments directed to Adams, these are also not clear. The same reasoning for the "oversized" toe box applied to White applies here. With respect to the outer layer being made of leather, leather is know to protect a foot for scrape as well as dropping impacts and therefore, it would have been obvious to make the outer layer of White or Adams out of leather to add this extra protection for the user's foot as well as the other elements of the shoe, i.e. protect the shoe from easily getting a hole in it and allowing the foam to spill out.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday from 6:30 am until 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Anthony D Stashick
Primary Examiner
Art Unit 3728

ADS